

Appl. No. 10/718,762
Reply dated January 12, 2006
Reply to Office Action of August 12, 2005

REMARKS

With the present amendment, claims 1-8 and 10-20 are in the case. Please amend claim 1 as shown on the attached listing. Support for the amendment to claim 1 may be found, for example, in claim 9 as originally filed. Please cancel claim 9 as shown on the attached listing of the claims. Claims 10 and 11 are amended to correct for prior dependency from now-canceled claim 9. Please cancel claim 21. Claims 17-20 are shown in the attached listing as "withdrawn" claims and Applicant affirms election of the Group I claims, and specifically reserves the right to seek patent protection for non-elected subject matter by divisional application. Therefore, claims 1-8 and 10-16 are presented for Examiner Desai's consideration.

Pursuant to 37 C.F.R. § 1.111, reconsideration of the present application in view of the following remarks is respectfully requested.

Applicant thanks Examiner Desai for including in the Office Action mailed August 12, 2005 a signed copy of the Initialed Forms PTO-1449 sent with Applicant's Information Disclosure Statements.

Claims Rejection, 35 U.S.C. §112

By way of paragraph 4 of the Office Action mailed August 12, 2005, claim 21 was rejected under 35 U.S.C. §112 because it was dependent from withdrawn claim 17. With the requested cancellation of claim 21, Applicant believes this rejection to now be moot.

Claims Rejection, 35 U.S.C. §102(b)

By way of paragraphs 5-12 of the Office Action mailed August 12, 2005, claims 1, 3, 5-8, and 12-16 were rejected under 35 U.S.C. §102(b) as allegedly being anticipated by and thus unpatentable over PCT Publication Number WO 02/42365 to Wu et al. (hereinafter, "Wu et al."). With the requested amendment of claim 1 to include the subject matter of claim 9, which formed no part of this rejection, Applicant believes this rejection to now be moot.

Claims Rejection, claims 2 and 4, 35 U.S.C. §103(a)

By way of paragraphs 13 and 14 of the Office Action mailed August 12, 2005, claims 2 and 4 were rejected under 35 U.S.C. §103(a) as allegedly being obvious in view

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of and thus unpatentable over PCT Publication Number WO 02/42365 to Wu et al. (hereinafter, "Wu et al."). With the requested amendment of claim 1 to include the subject matter of claim 9, which formed no part of this rejection, Applicant believes this rejection to now be moot.

Claims Rejection, claims 9 - 11, 35 U.S.C. §103(a)

By way of paragraphs 15-19 of the Office Action mailed August 12, 2005, claims 9-11 were rejected under 35 U.S.C. §103(a) as allegedly being obvious and thus unpatentable over Wu et al. in view of U.S. Pat. No. 5,308,663 to Nakagawa et al. (hereinafter, "Nakagawa et al."). This rejection is respectfully traversed to the extent it may apply to the currently presented claims, as described in the remarks below.

The invention as currently claimed is directed to a biodegradable, breathable film. The film includes about 30 percent to about 70 percent by weight of a biodegradable copolyester, about 70 percent to about 30 percent by weight of a filler, and a compatibilizer. The film has been stretched and has a WVTR of at least about 800 grams per square meter per 24 hours.

As noted in the Office Action, Wu et al. teach a biodegradable film including biodegradable copolymers and inorganic fillers. However, the Office Action also noted that Wu et al. do not teach use of compatibilizers as required by currently amended claim 1. To remedy this, the Office Action combines the teachings of Nakagawa et al. with Wu et al. to arrive at Applicant's invention. As noted in the Office Action, Nakagawa et al. teach that it is possible to impregnate a biodegradable nonwoven fabric with a fatty acid to give it repellency and to control the decomposition, and the Office Action equated this use of the fatty acid by Nakagawa et al. with Applicant's required compatibilizer. The Office Action then further states that one skilled in the art would be motivated to add the fatty acid of Nakagawa et al. to the biodegradable film of Wu et al. in order to form a biodegradable film that is water repellent.

Applicant respectfully disagrees. Specifically, Applicant asserts that no proper motivation has been shown for why one skilled in the art would be motivated by the teachings of either Nakagawa et al. or Wu et al., or even by knowledge generally available

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to one such, to add the fatty acid of Nakagawa et al. to the films Wu et al. The Office Action states that the motivation lies in making a biodegradable film that is water repellent.

However, intact films, by their very nature, are already liquid barrier materials and their use as such is well known to one skilled in the art. The nonwoven fabric taught according to Nakagawa et al. is a "web of cellulose-based fibers are combined with chitosan salt and an interfiber binder comprising a combination of chitosan salt and fine cellulose" (Abstract). Applicant respectfully submits that although one skilled in the art might learn from Nakagawa et al. to impregnate a cellulose-based fibrous fabric with fatty acid to give it water repellency (cellulosic fibers such as the pulp fibers used in Nakagawa et al. generally known to be water-absorbing), this teaching provides no motivation to impregnate fatty acids onto a film material (whether as a compatibilizer, or even as a water-repellent) because film materials are not water-absorbing cellulose-based fibrous webs and have no need of externally-added water repellents.

In addition, Applicant asserts that even if, absent motivation, one skilled in the art were to attempt to modify the films of Wu et al. according to the teachings of Nakagawa et al., one doing so still would not arrive at the invention. Nakagawa et al. teach impregnating the fibrous nonwoven material with fatty acid. Impregnation of one substance onto another material is an external process whereby the material is coated with the impregnating substance. Coating of a fatty acid onto the outside of a film will not serve to act as a compatibilizer, which is an ingredient of the film's composition, but would rather only result in a fatty-acid coated film.

For the reasons stated above, Applicant respectfully submits that, first, no proper motivation has been shown why one skilled in the art would combine Nakagawa et al. with Wu et al., and second, that even if such combination were made, one would not arrive at the invention. Therefore, Applicant respectfully requests that this rejection under 35 U.S.C. §103(a) over Wu et al. in view of to Nakagawa et al. be withdrawn.

Obviousness-type Double Patenting Rejection, Claim 1

By way of paragraph 20 of the Office Action mailed August 12, 2005, claim 1 was provisionally rejected under the judicially created doctrine of obviousness-type double patenting, over co-pending Application Serial No. 10/718,973. With the requested

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amendment of claim 1 to include the subject matter of claim 9, which formed no part of this rejection, Applicant believes this rejection to now be moot.

Obviousness-type Double Patenting Rejection, Claims 3, 5, 6, 9, 12, 14, 15, 16

By way of paragraph 20 of the Office Action mailed August 12, 2005, claims 3, 5, 6, 9, 12, 14, 15 and 16 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting, over co-pending Application Serial No. 10/718,973. Applicant respectfully requests this provisional rejection be held in abeyance with respect to the present application until such time as the presence of allowable subject matter is indicated.

For the reasons stated above, it is respectfully submitted that all of the claims are in form for allowance.

Please charge any prosecutorial fees which are due to Kimberly-Clark Worldwide, Inc. deposit account number 11-0875.

The undersigned may be reached at: 770-587-8908.

Respectfully submitted,

XIN NING

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CERTIFICATE OF FACSIMILE TRANSMISSION

I, Robert A. Ambrose, hereby certify that on January 12, 2006 this document is being faxed to the United States Patent and Trademark Office, central facsimile machine at (571) 273-8300.

By: Robert A. Ambrose

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